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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,771	11/24/2003	Alan Rezach	4002-3317	4899

7590 12/06/2006

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EXAMINER

PELLEGRINO, BRIAN E

ART UNIT PAPER NUMBER

3738

DATE MAILED: 12/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/720,771	Applicant(s) REZACH ET AL.	
	Examiner Brian E. Pellegrino	Art Unit 3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) 12-14, 17 and 39-44 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 34-38 is/are allowed.
- 6) ☒ Claim(s) 1-11, 15, 16 and 18-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's traversal is on the grounds that search and examination of the entire application can be made without serious burden to the Examiner, in particular, because the restricted groups overlap. Applicant's traversal has been carefully considered, but fails to establish error in the propriety of the present requirement for restriction and election.

Though Applicant asserts that examination of all pending claims would not pose an undue burden on the Examiner, such is not an accurate assertion in light of the disparate nature of the presently claimed subject matter as noted in the Requirement for Restriction of Groups I and II and the species.

Consideration of the plurality of inventions that Applicant has claimed would significantly compromise and preclude a quality examination on the merits. Furthermore, execution of a search encompassing the entirety of Applicant's grommet assembly would not only constitute an undue burden on the Examiner, but consideration of the findings of such a search in accordance with the requirements of the law under 35 U.S.C. §§101, 102, 103 and 112 would be unduly onerous.

Moreover, it is further noted that a comprehensive search for the presently claimed subject matter is not solely limited to a search of the classes and subclasses in which they are classified. Therefore, it is obvious that a comprehensive search of the copious amounts of patent and non-patent literature for each of the patentably distinct

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inventions and their permutations presently claimed would necessarily place an undue burden on the Examiner.

Therefore, for the reasons above and those made of record in the Requirement for Restriction of 12/19/05, the restriction requirement is deemed proper and maintained.

Claims 12-14, 17, 39-44 remain withdrawn from further consideration pursuant to 37 C.F.R. 1.142(b), as being to non-elected inventions, there being no allowable generic or linking claim.

Response to Amendment

The remarks filed on 6/7/06 have been considered but are ineffective to overcome the Taylor reference since the Applicant has not properly responded according to MPEP 718 since this requires an affidavit or declaration to disqualify commonly owned prior art under rule CFR 1.130.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

SL 1/1/06

Claims 1-10, 15, ~~16, 18~~, 25-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Amrein (6371957). Amrein discloses a receiver member (3) with a channel 6, at least one aperture 25 for a cylindrical closure member 20, and it can be construed that the channel forms a countersunk edge. Amrein also disclose a grommet member 75 having a passage and at least two prongs 62, being compressible extensions, (extending transverse to the passage (54) where the prongs are inserted

such that they are *adjacent* to the counter sunk opening, where the receiver and grommet are non-threadably and rotatably connected where upon assembly the fixing member **56** is lodged between the prongs via the internal threads **11**. The extensions may include a flange (shown in figure 1 and 10) or grooves as threads (27). In Fig. 10, the body of the receiver member **3** comprises two disks **52** & **53** with element 52 being construed as the intermediate member. In reference to claims 7 and 8, it can be seen (Figs. 2,3) that the grommet has a passage to hold a bone shank or bolt **1**. The nut (26) is a retaining ring which is threaded and whose threads fit into the threads of the extensions, where the threads are also grooves and an elongate member (1) may extend through a channel (Figure 3).

Claims 1-9,25 are rejected under 35 U.S.C. 102(b) as being anticipated by Hoffman et al. (WO 02/47564). Fig. 2 shows apparatus comprising a grommet member **80** and a receiver **52** having a channel that extends around the circumference of the body, an aperture **70** for a closure member and an opening **54** transverse to the channel. Fig. 4a shows the grommet member holding a block or cylindrical bone bolt **92**. Fig. 4b shows the grommet member with an extension **158** that is compressible since it is split with two prongs **186,186'**. It can be construed that portion **158** of grommet member is flanged since it has a larger diameter than portion **b** of the prongs. Additionally it can be seen that section **b** of the prongs include a groove **a** formed therein. Regarding claim 25, it could also be construed that opening **70** is a channel and has an elongate member **64** extending there through.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 19-24,29-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Amrein '579 in view of Taylor (6579292). Amrein is explained supra. However, Amrein does not disclose intermediate disks containing splines. Amrein also fails to disclose the use of silicone between the intermediate member and the receiver. Taylor teaches splines on the intermediate members (Figure 2) in the same field of endeavor or the analogous art of connection assemblies for the purpose of connection of implants and rods. Taylor teaches the use of silicone to secure components together such that they do not separate, col. 7, lines 13-34. It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teaching of spline, as taught by Taylor, to the disks as per Amrein, in order to provide a directional locking means and the ability to limit the rotation of the device. Additionally, it would have been obvious to one of ordinary skill in the art to utilize silicone as taught by Taylor with the receiving member of Amrein such that it prevents any of the parts from separating within the patient or during surgery.

Claims 10,11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman et al. (WO 02/47564) in view of Ramsey (4946122). Hoffman is explained supra. It can be seen that Hoffman's opening 54 on the receiver apparatus is an extension off the body. However, Hoffman does disclose the use of a retaining ring for use within a groove on the extension. Ramsey teaches (Fig. 3) the use of a retaining

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ring **90** to hold the grommet member within a receiver. It would have been obvious to one of ordinary skill in the art to incorporate a retaining ring as taught by Ramsey to hold the Hoffman extension having a groove in the receiver member to prevent it from being removed in a patient.

Allowable Subject Matter

Claims 34-38 are allowed.

Response to Arguments

Applicant's arguments filed 6/7/06 have been fully considered but they are not persuasive. Applicant argues that the components of the Amrein device that were considered by the Examiner to be a grommet member and receiver member are not rotatable. Clearly, since they are separate components and are assembled together they can be rotated to connect them. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., that the grommet member and receiver can rotate after assembly such that it can accommodate a stabilization rod in any position) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant also states that the opening of receiver **3** is not an aperture for the closure member **20**. Since the closure member of Amrein does pass or is within the opening of receiver, it can be construed to be for the closure member.

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Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian E. Pellegrino whose telephone number is 571-272-4756. The examiner can normally be reached on Monday-Thursday from 7am to 5:30pm. The examiner can also be reached on alternate Fridays. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TC 3700, AU 3738

BRIAN E. PELLEGRINO
PRIMARY EXAMINER

